

REMARKS/ARGUMENTS

Claim Rejections—35 U.S.C. § 112 ¶1

3. Claims 37-39 rejected under 35 U.S.C. § 112, ¶ 1 – failure to comply with the written description requirement.

The Applicant respectfully traverses the Examiner's suggestion that the limitation of newly added claim 37, line 5 (i.e., "chemically reactive substances are exposed on the sides of the filaments") is not supported by the instant specification.

Page 4, lines 16-21 of the specification states:

the present invention provides a chemical screening apparatus having at least two different strips of a non-reactive substrate extending along a longitudinal axis and, supporting spaced along that longitudinal axis, a linear array of different chemically reactive sampling compounds exposed on a surface of the strip.

Compounds spaced along a longitudinal axis of a strip must be on the sides of the strips not the ends of the strips. The plain and ordinary meaning of "longitudinal" is length and this is also how longitudinal is defined in the present application at page 8, lines 26 and 27 of the present application.

The specification need not describe the claimed subject matter in exactly the same terms as used in the claims if one skilled in the art would recognize upon reading that the new language reflects what the disclosure shows has been invented. See All Dental Prodx, LLC v. Advantage Dental Products, Inc., 309 F.3d 744 (Fed. Cir. 2002). In this case, it is believed that the word "sides" provide a clear understanding of the claim limitation.

The disclosure includes not only the specification and the claims, but also the drawings.

Figures 2, 6 and 7 show the successive addition of nucleotides on the side of a filament.

Claim Rejections—35 U.S.C. § 103 (a)

4. Claims 1, 2, 5-7, 9, 34, 36-38, and 40 rejected under 35 U.S.C. § 103 (a) – Gross (U.S. Pat No. 4,867,946) in light of Adams (U.S. Pat. No. 6,156,494).

Gross teaches the use of large paper strips to detect substances present in the urine. Unlike the invention in the present application, the test strips of Gross are exactly the same. There is no customization of the test strips (column 1, lines 5-9 – urine test strips are exactly alike, there is no variation of the test sections between each urine test strip) in Gross as there are in the invention in the present application. Accordingly, Gross does not teach the use of semi-selective, non-reactive strips to screen chemical compounds.

Adams teaches the use of optical fibers to synthesize and screen combinatorial libraries of oligomeric and non-oligomeric compounds. Unlike the invention in the present application, the optical fibers of Adams are bundled side by side into an imaging fiber/optical sensor (column 3, lines 1-4; column 3, lines 10-12) and it is apparent from the description of the invention and its use, and from the figures, that the chemical compounds are placed on the ends, not the sides, of the fibers.

Thus, alone or in combination, these references do not teach the limitations of claims 1, 34, 35, and 36, all of which require different strips with chemically reactive test substances on the sides of the strips. Nor do these references alone or in combination teach the kit of claim 41 discussed below. All of the independent claims are thus allowable over this combination assuming this combination is suggested by the art.

In fact, this combination is not suggested by the art. Adams teaches away the semi-customizable array of the present invention by describing a system of synthesis of multiple compounds in place on a pre-assembled bundle. There is no suggestion in Gross or Adams that would lead a person of ordinary skill in the art to combine the Adams optical fiber synthesis system with the Gross paper strips system. The purposes of either of these two inventions would be ill-served by the apparatus of the other invention.

The Examiner gives no patentable weight to the limitation, “support frame holding the plurality of different filaments for mutual exposure to a material to be screened,” in claims 1, 34, and 36 because it is a statement of intended use. This is

incorrect because this statement defines how the strips are held, whether or not screening ultimately occurs.

The Applicant has reintroduced a kit claim into this case as claim 41. Such a claim form was previously rejected by the Examiner because the Examiner believed there was no support for the phrase "a chemical screening kit" (paper 13, paragraph 2). The fact of a kit was clearly disclosed at page 10, lines 7-17, as noted by the Applicant, however, in the interest of expediting the prosecution, the Applicant previously had amended the preamble to the phrase "semi-custom array for chemical screening" a phrase now given no weight by the Examiner.

The validity and proper interpretation of a "kit claim," was established by In re Venezia, 530 F.2d 956 (C.C.P.A. 1976). Generally kit claims do not require the parts of an invention to be made into a complete assembly. See also, MPEP § 2173.05(g) (2004). It is irrelevant what may or may not be assembled in the future; what is required are present limitations to help define the invention. Id. at 958. Furthermore, Venezia also permits futuristic and conditional language, particularly in the form of "to be" phrases in a claim. Id. Applicant believes that claims 1, 34, 36 and 40 comply with the requirements set forth in Venezia for valid "kit claims" – the claims include present structural limitations and properly use "to be" phrases to indicate intended/future use.

The Examiner also noted that the phrase, "semi-custom array for chemical screening," in claims 34 and 36 are not given patentable weight because of Kropa v. Robie, 88 U.S.P.Q. 478 (C.C.P.A. 1951). Kropa, however, allows the preamble language to be given patentable weight when "the preamble was considered necessary to give life, meaning, and vitality to the claims." Id. at 481. The court noted that a preamble is given meaning "when there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them." In the present case, a semi-customizable array for chemical screening has neither been previously conceived nor known to others. Thus, the preamble should be given patentable weight to distinguish these claims over the prior art.

New claim 42 to moves this language out of the preamble.

5. Claims 10-13 rejected under 35 U.S.C. § 103 (a) – Gross (U.S. Pat. No. 4,867,946) in light of Bensten (U.S. Pat. No. 6,372,895).

The teachings of Gross are described above.

Bensten teaches a method of making and using fluorogenic compounds as a means to detect enzyme activity in biological samples. Unlike the present invention where a bar code marks the filaments, the reactive fluorogenic compounds of Bensten are a bar code itself (column 7, lines 56-60). Thus, the bar code of Bensten identifies the reaction of a test substance with the test compounds and does not identify the filament as required by the present claims. In other words, Bensten does not teach the use of a bar code to identify the filaments but only uses the bar code to identify how the filaments react in a given experiment. Thus, there is no teaching suggesting for the modification of Gross by Bensten or a combination of Gross and Bensten.

In light of these amendments and remarks it is believed that claims 1, 2, 5-13, and 34-42 are now in condition for allowance and allowance is respectfully requested.

Respectfully submitted,
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